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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,240	01/07/2000	Michel H. Klein	1038-1000 MIS	2813

7590 02/21/2002
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EXAMINER

NAVARRO, ALBERT MARK

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 02/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/479,240

Applicant(s)
Klein et al

Examiner
Mark Navarro

Art Unit
1645



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 3, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59, 61-70, and 72-74 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 59, 61-70, and 72-74 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/001,554.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Art Unit: 1645

DETAILED ACTION

Applicant's amendment filed January 3, 2002 (Paper Number 9) has been received and entered. Claims 60, 71 and 75-76 have been canceled, consequently claims 59, 61-70, and 72-74 are pending in the instant application.

Claim Objections

1. The objection of claims 60 and 71 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim is withdrawn in view of the cancellation of said claims.

Claim Rejections - 35 USC § 112

2. The rejection of claims 62 and 72 under 35 U.S.C. 112, first paragraph, as lacking complete deposit information for the deposit of plasmid pD2 RF-HN (ATCC 75388) is withdrawn in view of Applicant's assurances.

Double Patenting

3. The rejection of claims 59-74 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,968,776 is withdrawn in view of Applicant's filing of a terminal disclaimer, which has been recorded.

Art Unit: 1645

4. The rejection of claims 59-74 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,225,091 is withdrawn in view of Applicant's filing of a terminal disclaimer, which has been recorded.

5. The rejection of claim 65 under 37 CFR 1.75 as being a substantial duplicate of claim 61 is withdrawn in view of Applicant's assertions.

The following new grounds of rejection are applied:

Claim Objections

6. Claims 70 and 72-74 are objected to because of the following informalities: Claims 70 and 72-74 recite non-elected inventions. It is noted that Applicant's assert that claim 70 has been amended to recite the hybrid gene PIV-HN and RSV-F, (page 3 of response filed January 3, 2002). However, no amendment to the claims was submitted. Amendment of the claims as indicated by Applicant's intentions will be sufficient to overcome this objection. Appropriate correction is required.

Art Unit: 1645

Specification

7. Applicant's are requested to amend the first line of the specification to recite the appropriate claim of priority.

8. The amendment filed January 7, 2000 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Applicant's have amended the sequence in Figure 5 to recite a new nucleotide sequence at positions 540 and 630, and have further changed the resulting amino acid at the position corresponding to site 630 of the nucleic acid sequence. Each of these changes are deemed new matter. Applicant's assert that these are merely spelling mistakes, however, without support in the originally filed specification to show the correct sequence, these changes are new matter. This objection further extends to the electronically filed copy of the sequence listing. Applicant is required to demonstrate clear support for making the sequence revisions, or cancel the newly added material from both the specification and the electronically filed disk of sequences in the reply to this Office action.

Lastly, it is noted in Applicant's response filed January 3, 2002 (Paper Number 9) that a further IDS is enclosed with respect to the Chanock and Prince et al references. However, this

Art Unit: 1645

paper appears to have been separated from the response. Applicant's are requested to resubmit the IDS form in response to this Office action.

Claims 59, 61-70, and 72-74 are objected to in view of the amendment to the sequences within the specification, however claims 59, 61-70 and 72-74 are free of the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Navarro, whose telephone number is (703) 306-3225. The examiner can be reached on Monday - Thursday from 8:00 AM - 6:00 PM. The examiner can be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Lynette Smith can be reached at (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1645 by facsimile transmission. Papers should be faxed to Group 1645 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the official Gazette 1096 OG 30 (November 15, 1989). The CMI Fax Center number is (703) 308-4242.


Mark Navarro

Primary Examiner

February 21, 2002